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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,258	04/12/2001	Carlos De La Huerca	250591.90295	3649
26710	7590	06/24/2004	EXAMINER	
QUARLES & BRADY LLP 411 E. WISCONSIN AVENUE SUITE 2040 MILWAUKEE, WI 53202-4497			LINDINGER, MICHAEL L	
			ART UNIT	PAPER NUMBER
			2841	

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/833,258

Applicant(s)

DE LA HUERGA, CARLOS

Examiner

Michael L. Lindinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-158 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-158 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.

- 4) ☐ Interview Summary (PTO-909)  
Paper No(s)/Mail Date: \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

  
DAVID MARTIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-158 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild U.S. Patent No. 5,802,015 in view of Foote U.S. Patent No. 6,036,231. Regarding Claims 1-52 and 100-158, Rothschild teaches an apparatus comprising enhanced (intelligent) label for configuring an indicating configuration to be associated with a container, wherein the apparatus includes an indicator 14 and data stored thereon related to an enhanced memory device, wherein the apparatus is a medication container 11, as well as the apparatus having a processor for programming a variety of data and sub-sets of information related to a user such as patient name, medication, dosage schedule, specific instructions, wherein the apparatus is configured to be updated by a pharmacy computer system, wherein the label apparatus has the ability to print the smart label via a programming from a computer and printer port (Col. 4, lines 50+; Col., 5, lines 1; FIG. 1-2). Rothschild does not explicitly teach an apparatus to print enhanced labels, as well as non-enhanced labels. Foote teaches a pharmacy label and

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printing means comprising a computer system, wherein the system includes a host computer 12 and a supplemental computer 22. The supplemental computer is connected to a conventional external memory 24 and a conventional laser system 26, wherein the computer system has the ability to program, update, and adjust label and printer information based on the user's preferences (Col. 3, lines 1+; Col. 4, lines 1+; FIG. 1). It would have been obvious to a person skilled in the art at the time of the invention to adapt the printing system of Rothschild with the ability to send programmable signals to a printing system to control the type of information that is printed on the labels. By providing a computing and printing system to alter between printing enhanced or un-enhanced labels, a user has control over the type and quantity of a specific label, as well as possess the ability to change the label's information on a moments notice.

Regarding Claims 53-99, the combined teachings of the Rothschild and Foote references inherently possess the methods of providing sub-sets of medication stored in a container including an enhanced device for storing data related to medications in the container, as well as the corresponding mounting and assembling steps needed to construct the apparatus.

***Prior Art***

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- McKee U.S. Patent No. 4,972,657 discloses a method of packaging medication for controlled dispensing by assigning unique numerical codes.
- Jahier U.S. Patent No. 5,271,642 discloses a marking label for a product comprising multiple bar identification codes and a plurality of target areas.
- Griffiths U.S. Patent No. 5,435,600 discloses a prescription pharmacy label comprising multiple writing portions and coating means.

***R s p o n s e A r g u m e n t s***

1. Applicant's arguments filed February 5, 2004 have been fully considered and are persuasive. Although the current application is not under a Final Rejection, the Examiner wishes to further comment on the material of the invention. The Attorney of Record and the Examiner conducted an informal phone interview, wherein the Attorney explained the actual point and scope of the invention was not necessarily the enhanced memory device as the Examiner misunderstood (as previous rejections over Maestre, etc. demonstrated), but rather the current invention is that of a printing apparatus that has the ability to print both enhanced devices, and non-enhanced devices. The rejections and references utilized above better read on the scope of the invention.

Also within the arguments, the Applicant focuses on assuming what type of actions or behavior that would influence programming or control of his medication container. These features are not only without representation in the Claims, but assuming functional use is not patentable. Regarding claims directed to attachment features, case law has been established upholding the inventive step of parts being integral with one another during a manufacturing process or assembled afterward is recognized as an equivalent apparatus.

***C nclusi n***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael L. Lindinger whose telephone number is (572) 272-2106. The examiner can normally be reached on Monday-Thursday (7:30-6).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Martin can be reached on (572) 272-2107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael L. Lindinger  
Examiner  
Art Unit 2841

April 26, 2004  
MLL